

In re Application of: ARENA, et al.
Confirmation No: 8505
Application No.: 10/687,328
Examiner: SWITZER, J.C.

REMARKS

Claims 1-10 are pending in the application. The elected claims set forth, herein, are merely to comply with the Restriction Requirement and is not to be construed as surrender of any subject matter in the instant application. Applicants hereby reserve the right to pursue the subject matter of the canceled claims in one or more divisional patent applications.

Applicants would like to draw the Examiner's attention to the mutation 5217 which is an A>G mutation and not G>A. The correct mutant is shown, for example, in Table 1, page 7; Table 3 page 9 of the instant application.

Restriction Requirement

In the above-identified Office Action, the examiner set forth a restriction requirement and required election of one of the following groups under 35 U.S.C. § 121:

- Group I: Claims 1-10, all in part, drawn to methods for analyzing a biological sample for the presence or a genetic polymorphism or mutation wherein the mutation is 4959C>T in the BRCA1 gene, classified in class 435, subclass 6.
- Group II: Claims 1-10 all in part, drawn to methods for analyzing a biological sample for the presence or a genetic polymorphism or mutation wherein the mutation is 5217G>A in the BRCA1 gene, classified in class 435, subclass 6.
- Group III: Claims 1-10 all in part, drawn to methods for analyzing a biological sample for the presence or a genetic polymorphism or mutation wherein the mutation is 1503A>C in the BRCA2 gene, classified in class 435, subclass 6.
- Group IV: Claims 1-10 all in part, drawn to methods for analyzing a biological sample for the presence or a genetic polymorphism or mutation wherein the mutation is 5996A>C in the BRCA2 gene, classified in class 435, subclass 6.

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Group V: Claims 1-10 all in part, drawn to methods for analyzing a biological sample for the presence or a genetic polymorphism or mutation wherein the mutation is 8688A>C in the BRCA2 gene, classified in class 435, subclass 6.

In response, Applicants elect Group II: Claims 1-10 all in part, drawn to methods for analyzing a biological sample for the presence or a genetic polymorphism or mutation wherein the mutation is 5217A>G in the BRCA1 gene, classified in class 435, subclass 6. This election is made with traverse. Applicants submit that the mutations were discovered in African-American women with early onset of breast cancer. The importance of detection of one or more of these mutations is an early indicator of breast cancer. The test is more reliable using a panel of these markers. Early detection of breast cancer is important in saving many lives.

Applicants submit that a search of early onset of breast cancer mutations would reveal, if any, literature pertaining to any one of the above groups (Groups I-V), and would therefore, not be an undue burden. Applicants respectfully request the lifting of the restriction requirement and prosecuting Groups I through V would result in a significant savings of time and resources for both the Patent Office and Applicants.

The Examiner has also requested a restriction of claim 2. In response, Applicants elect 5217A>G and 4959 C>T. This election is made with traverse for the above reasons.

The elected claims set forth, herein, are merely to comply with the Restriction Requirement and is not to be construed as surrender of any subject matter in the instant application. Applicants hereby reserve the right to pursue the subject matter of the canceled claims in one or more divisional patent applications. Based on the above election, Applicants request removal of the restriction requirement and substantive examination of all elected claims. Applicants invite the Examiner to call the undersigned if it is believed that the above restriction

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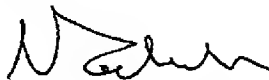
election is incomplete or improper in any way, or if a telephonic interview will expedite the prosecution of the application to an allowance.

In view thereof, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

CONCLUSION

In view of the foregoing, reconsideration and withdrawal of all rejections and allowance of the application is respectfully solicited. If there are any remaining issues or the Examiner believes that a telephone conversation with the Applicants' attorney would be helpful in expediting prosecution of this application, the Examiner is invited to call the undersigned at telephone number shown below. This response is accompanied by a petition for a three month retroactive extension of time and the required fee. The Commissioner for Patents and Trademarks is hereby authorized to charge the amount due for any retroactive extension of time and any deficiency in any fees due with the filing of this paper or credit any overpayment in any fees paid on the filing, or during prosecution of this application to Deposit Account No. 50-0951.

Respectfully submitted,
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